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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL MASCHKE

Appeal 2009-007413
Application 10/804,707
Technology Center 3700

Oral Hearing Held: June 17, 2010

Before WILLIAM F. PATE, III, STEFAN STAICOVICI,
FRED A. SILVERBERG, *Administrative Patent Judges.*

APPEARANCES:

ON BEHALF OF THE APPELLANT:

STEVEN H. NOLL, ESQUIRE
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1 The above-entitled matter came on for hearing on Thursday, June 17,
2 2010, commencing at 9:32 a.m., at the U.S. Patent and Trademark Office,
3 600 Dulany Street, Alexandria, Virginia, before Paula Lowery, Notary
4 Public.

5 CLERK: Good morning, Calendar Number 46, Appeal No. 2009-007413,
6 Mr. Noll.

7 JUDGE PATE: Good morning, Mr. Noll.

8 MR. NOLL: Good morning.

9 JUDGE PATE: We've taken an opportunity to look at this case beforehand,
10 so we're up to speed on the technology. We'd like to hear your arguments
11 about patentability.

12 MR. NOLL: My pleasure. As you know, our basic reference is the
13 Lenelson reference. We have a rejection under 103 based on Lenelson and
14 Koch.

15 I won't say too much about the Koch reference. The Examiner relied on it
16 because it has a magnet at the tip. We agree it provides such a teaching, but
17 that's not really our basis for patentability, or our basis for distinguishing
18 over the art.

19 So I'll devote most of my time to discussing the Lenelson reference. As you
20 know from reading the Briefs, our claimed invention is a catheter that is
21 magnetically guided in the body of a patient by means of a static magnetic
22 field in which the catheter and the patient are placed.

23 The catheter itself contains a number of individually controllable
24 electromagnets that are each controlled so as to give the respective
25 electromagnets different magnetic moments. That allows a very robust

1 guidance of the catheter through the body in this magnetic field by
2 interaction of the electromagnets with the static, external magnetic field.
3 The Lenelson reference, as a fundamental difference, is a catheter that has
4 either permanent magnets or electromagnets in it that is placed in an external
5 field where the external field is the controlled field. By controlling the
6 external field and by interaction of that controlled external field with the
7 magnets, the Lenelson guidance of the catheter is achieved in that manner.
8 The key point, as you can see from our Briefs, is whether the Lenelson
9 reference discloses that any of these magnets in the catheter have different
10 magnetic moments when the current is supplied to them.
11 As we've noted, the primary disclosure of the Lenelson reference is, we
12 think, to use permanent magnets; but it does make mention of an alternative
13 use of electromagnets. For the reasons which we cited in our Brief, which I
14 won't detail again, the electromagnets are described in Lenelson, we believe,
15 only as alternatives, or something that will be operated or used to resemble
16 the permanent magnet.
17 That by itself to us says they are not, should not, and cannot be individually
18 controllable electromagnets. Otherwise, they wouldn't resemble the use of
19 the permanent magnets.
20 Even more importantly, this reference, of course, was heavily discussed
21 during the prosecution before the Examiner; and we specifically amended
22 our claim language to preclude the interpretation of this reference that the
23 Examiner is now giving. That is, to include specific language in our claim
24 that states that the electromagnets that have different magnetic moments are
25 magnets that have current supplied to them.

1 The Examiner is only able to interpret the Lenelson reference as having
2 electromagnets with different magnetic moments by virtue of saying that
3 some of these electromagnets at any given time might be activated. Some
4 might be not activated, and the Examiner contends that the nonactivated
5 magnets thus have a magnetic moment of zero.

6 Our position is a nonactivated electromagnet is no different than the example
7 we gave in our Brief of a pencil, or any other inanimate object, without any
8 current supplied to it for which the concept of a magnetic moment is
9 meaningless.

10 It's only useful and meaningful to use the concept of a magnetic moment to
11 something that is actually generating or exhibiting a magnetic field. A
12 nonactivated electromagnet just doesn't do that.

13 You can take that concept of the Examiner to the extreme and say something
14 that is red could also be called green because at any given moment it has a
15 green value of zero. So this is a very slippery slope, we believe, to just call
16 something that has no magnetic attributes at all as having a magnetic
17 moment of zero.

18 That's the one factor just in terms of whether any of these magnets have
19 different magnetic moments; but it's also a distinguishing feature, we
20 believe, with regard to the Lenelson catheter that even the activated magnets
21 in that catheter when activated are all activated the same. They're all
22 supplied with the same current.

23 As I said, they're intended to resemble permanent magnets, which means
24 they must all be virtually identical. So even for the activated magnets in the
25 Lenelson catheter, none of them have different or varying magnetic
26 elements. They all have the same identical magnetic moment.

1 That's basically our argument. The fundamental difference between the type
2 of control that's used in the catheter -- this catheter of the invention is used
3 in an external static field. The Lenelson reference is used in an external
4 controllable field. There's no magnets with varying magnetic moments
5 disclosed in the Lenelson, et al. reference; and there's no electromagnets that
6 are individually controllable disclosed in the Lenelson reference.

7 All of those factors, we believe, actually teach a person of ordinary skill
8 away from making any modifications of the Lenelson reference in a
9 direction toward the claimed subject matter. Even if those sorts of changes
10 proposed by the Examiner were made for reasons that we're not able to
11 discern, that would involve such a substantial redesign of the Lenelson
12 system to change it from the basic fundamental operating concept that's
13 disclosed in that reference that we believe those changes would themselves
14 be evidence of nonobviousness and be sufficient to reverse the rejection.
15 I'd be glad to take any questions or hear any comments you have.

16 JUDGE PATE: Any questions?

17 JUDGE STAICOVICI: I have one question. Lenelson specifically states
18 using strong magnets, or more preferably, electromagnets in it. So I get the
19 feeling that they prefer electromagnets to permanent magnets.

20 MR. NOLL: That might be the case, I wouldn't dispute that; but even if
21 that's the case, as I said, the use of electromagnets is intended to cause them
22 to behave as closely as possible to permanent magnets. Even when they use
23 permanent magnets in order to achieve the feature that I mentioned of
24 having some magnets activated and some magnets deactivated, they talk
25 about putting the permanent magnets at different locations along the length
26 of the catheter.

1 So whatever they're doing, whether they're using permanent magnets or
2 electromagnets, I believe they're trying to accomplish the same thing and
3 make them resemble each other as closely as possible.
4 JUDGE PATE: I think we understand your arguments, and we're going to
5 take this case under advisement.
6 MR. NOLL: Thank you very much.
7 JUDGE PATE: Thank you.
8 Whereupon, the proceedings at 9:41 a.m. were concluded.

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